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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Daniel Willis

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EXAMINER

OMOTOSHO, EMMANUEL

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/775,195	<b>Applicant(s)</b> WILLIS, DANIEL	
	<b>Examiner</b> EMMANUEL OMOTOSHO	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/9/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22,32,33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language calls a first network and second network for receiving game instruction data and broadcast data, however, it is unclear how this is possible when applicants disclosure presents the first network and second network to be the same network (i.e. one network).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2,6-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada US Patent No. 6,929,549 B1.

Yamada teaches a digital television set system comprising:

5. Claim 1: a receiver for receiving digital television signals from at least a communication channel and a gaming console for use as a gaming client, the gaming console connected to the receiver (Par 7 lines 8-19, 40-46). A volatile storage memory

for having stored therein client instruction data relating to a gaming client and game instruction data relating to a current game in execution (Par 23 line 63- Par 24 line 24, Par 24 lines 19-24). An external storage medium reading circuit for sensing data from an external storage medium and for storing the received data in the at least a volatile storage medium (Par 14 lines 34-40, Par 23 line 63- Par 24 line 24, Par 24 lines 19-24). A processor in communication with the volatile storage medium, the processor operable to retrieve the game instruction data therefrom and to execute the game instruction data to execute a game on the gaming console, and operable to retrieve client instruction data therefrom and to execute the client instruction data to execute a gaming client function on the gaming console wherein the volatile storage medium further comprises set-top client instruction data and set-top application instruction data, and wherein the processor is further operable to retrieve the set top client instruction data and the set top application instruction data from the volatile storage medium and operable to execute the set top client instruction data and the set top application instruction data to extract video information from digital television signals and to display the extracted video information (Fig 3-5, 8-11).

6. Claim 2: an external local storage medium wherein the client instruction data and game instruction data are loaded from the external local storage medium into the at least a volatile storage medium (Par 13 lines 42-50, line 65 – Par 14 line 6, Par 15 lines 9-42 and Par 8 lines 59-63).

7. Claim 5: a transceiver for establishing a connection to a broadband access network and wherein the set top client instruction data and the set top application

instruction data are received from the broadband access network and loaded into the volatile storage medium (Par 3 lines 9-19, Par 7 lines 8-19, 40-46).

8. Claim 6, 22, 33-37: a gaming console being part of digital television set system and coupled to a receiver for receiving digital television signals from at least a communication channel, the gaming console comprising at least a processor and at least a storage medium, and being in connection with a monitor and a sound system (Par 7 lines 8-19, 40-46,). Receiving first instruction data from an external storage medium read by the gaming console and including one of set-top instruction data for receiving and decoding digital broadcast data when executed on the gaming console and communication data for use in retrieving via the receiver the set-top instruction data for receiving and decoding digital broadcast data when executed on the gaming console (Par 9 lines 4-11, Par 10 lines 20-31). Executing the set-top box instruction data on the gaming console, receiving encoded digital broadcast data via the receiver, decoding the received, encoded digital broadcast data and displaying the decoded digital broadcast data on the monitor and on the sound system (Par 10 lines 20-52).

9. Claims 7-8: the set top instruction data are received from the receiver and an external storage medium in connection with the gamin console (Par 10 lines 20-31)

10. Claim 9, 23: receiving a conditional access module and verifying access authorization for encoded digital broadcast data with the conditional access module (Par 25 lines 17-23).

11. Claim 10, 24: wherein the access authorization is verified using authorization data provided from a smart card, the smart card in connection with the gaming console through an interface (Par 25 lines 17-23).
12. Claim 11, 25: encoded digital broadcast data are scrambled, encoded digital data (Par 9 lines 32-37).
13. Claim 12, 26: the scrambled, encoded digital broadcast data is descrambled by the conditional access module before being decoded (Par 14 lines 46-54).
14. Claim 13, 27: wherein the gaming console is in communication with a monitor and is emulating a set top box for receiving and displaying on the monitor, services other than gaming services (Par 25 line 62- Par 26 line 9).
15. Claims 19-21, 28-31: wherein the services relate to digital television broadcast, transmission control protocol/internet protocol access, or interactive television applications (Par 25 line 62- Par 26 line 9).
16. Claim 32, 34: wherein the first network and the second network are the same (fig. 4, i.e. the network of the entertainment system is one)

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada.

20. Claims 3-4: Yamada fail to specifically disclose that the external storage medium is a compact disc/removable read-only memory cartridge. Applicant did disclose that choosing a compact disc/removable read-only memory cartridge as the memory medium for an external local storage medium provides an advantage, used for a particular purpose or solves a stated problem. Yamada teaches that the information is capable of being stored on a removable memory (Par 14 lines 62-67). Therefore, the examiner views this limitation of choosing between different types of memory mediums as a mere design choice well within the skill set of an ordinary skilled artisan.

21. Claim 14: Yamada teaches wherein the monitor is a monitor included in an analog transmission television set for a gaming machine with an analog transmission television set (Par 21 lines 45 - 67)

22. Claims 15-18: In the second embodiment, Yamada teaches that the gaming console is in communication with at least another network such as a community antenna television network, a telephone line network or a wireless network to solve the

problem of the obstructive connection of the devices in the first embodiment (Par 25 line 62- Par 26 line 9, Par 17 lines 53-62).

### Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Knee et al. US Patent 5,589,892 – Teaches a gaming system that also functions as a set-top box.
- b. Naiff US Patent 5,982,363 – Teaches a personal computer that provides the functions of a set-top box.

### ***Response to Arguments***

1. Applicant's amendments filed 1/9/08 are sufficient enough to overcome the objection to the drawings and the rejection under 35 U.S.C. 112 second paragraph. The objection and rejection has been withdrawn.
2. Applicant's arguments filed 1/9/08 have been fully considered but they are not persuasive.
3. On page 14, applicant argues, "Yamada discloses a system with a game machine, a set-top box that is distinct from the game machine, and a TV. Yamada does not disclose that the game machine or a processor thereof is operable to execute set,top instructions to extract video signals from digital satellite broadcast signals and to display the information in the video signals. The functionality of extracting video signals



from digital satellite broadcast signals remain with the set-top box. Additionally, Yamada does not disclose that its set-top box or a processor thereof is operable to execute game software; the set-top box downloads and stores the game software and provides the game software to the game machine for execution.”

4. The examiner respectfully disagrees. As can be seen in col 8:26-61, it is the gaming system's CPU that **executes instructions to** connect to the network, to extract video signals and to run the game software. In other words, it is the gaming system's processor that signals the system to connect to the network, extract video signals and run the game software.

5. On page 15, applicant argues, “Yamada does not disclose that the game machine, the set-top box, or the television receiver receives from external storage set-top instruction data or communication data for retrieving the set-top instruction data. The game machine in Yamada can receive game software from the set-top box, but Yamada does not disclose that the game machine can receive set-top instruction data for decoding digital broadcast signals or communication data for retrieving set-top instruction data. In Yamada, the digital broadcast signal decoding functionality is not associated with the game console. Thus, Yamada does not anticipate claim 6. This rejection should be withdrawn.”

6. The examiner respectfully disagrees. The current claim language calls for “set-top instruction data **for** receiving and decoding digital broadcast data” and “communication data **for** use in retrieving via the receiver the set top instruction data for receiving and decoding digital broadcast data”. The ‘selection control signal’ taught by

Yamada in (Par 7 lines 8-19, 40-46) meets these limitation since this data is needed for the receiving, decoding and communicating process to begin.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMMANUEL OMOTOSHO whose telephone number is (571)272-3106. The examiner can normally be reached on m-f 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO

/Ronald Laneau/  
Supervisory Patent Examiner, Art Unit 3714

04/12/08